

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Clark A. Landis, et al.

Title: DIAZAPHOSPHACYCLES

Appl. No.: 09/911,367

Patent No.: 7,071,357

Filing Date: July 23, 2001

Examiner: Jon D. Epperson

Art Unit: 1639

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
DETERMINATION UNDER 35 U.S.C. § 154(b)(3)(B)(ii)

MAIL STOP Patent Term Extension
Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants are in receipt of the Issue Notification for the above-referenced application. Applicants disagree with the Determination of Patent Term Adjustment (PTA) under 35 U.S.C. § 154(b) and present the following facts per the procedure set forth in 37 C.F.R. § 1.705(d) to support their contention that the patent term adjustment should be 1,041 days based on the grant date instead of the 804 days calculated by the United States Patent and Trademark Office (USPTO).

BASIS FOR THE ADJUSTMENT

On February 23, 2004, and prior to the payment of the Issue Fee on April 2, 2004, a Request for Reconsideration of Patent Term Adjustment was filed by the applicant, based on PTA discrepancies which existed at allowance. A Decision on Application for Patent Term Adjustment was granted in favor of applicant on March 17, 2006, and the days at issue were credited back to the applicant's total PTA. However,

according to the PTO's Patent Term History, the applicant was then charged a negative 120 days for filing said petition. Pursuant to 37 C.F.R. sec. 1.704(e):

Submission of an application for patent term adjustment under sec. 1.705(b) (with or without request under sec. 1.705(c) for reinstatement of reduced patent term adjustment) will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

On September 1, 2005, a Notice Under C.F.R. sec. 1.251 was issued, informing the applicant that the patent file could not be located by the PTO, and setting a time period of six months during which the applicant was to provide copies of all correspondence between the PTO and the patentee. A Reply to Notice Under 37 C.F.R. sec. 1.251 was filed on September 22, 2005, and received by the PTO on September 26, 2005. Subsequently, the applicant was charged a negative 120 days for said submission, even though there were no circumstances under which the applicant failed to engage in reasonable efforts to conclude prosecution of the application.

Finally, the PTO has miscalculated the number of days from payment of the issue fee to grant (i.e., 704 days). The Patent Term History reflects that the issue fee was received by the PTO on March 30, 2004. However, the issue fee was transmitted via First Class Mail, and was stamped received by the PTO on April 2, 2004. Therefore, the correct number of days from the PTO's receipt of the issue fee payment to the grant date should be 701 days, not 704 days. Accordingly, a total of 3 days should be deducted from applicant's total PTA.

In summary, the PTO erroneously deducted 240 days from applicant's total PTA. However, after deducting the 3 days which were miscalculated by the PTO from the date of receipt of payment of the issue fee to grant, PTA in favor of the applicant should be 1041 days at grant.

The Commissioner is hereby authorized, in accordance with 37 CFR § 1.16-1.17, to charge Deposit Account No. 50-2350 for the fee of \$200.00 to cover the

requisite fee associated with filing this request as specified in 37 C.F.R. § 1.18(e) and 37 C.F.R. § 1.705(b)(1). Furthermore, the Commissioner is hereby authorized to charge any additional fee(s) which may be required regarding this application under 37 CFR § 1.16-1.17, or credit any overpayment to Deposit Account No. 50-2350. A duplicate of this document is enclosed for such purpose.

Respectfully submitted,

Date September 1, 2006

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